

INTELLECTUAL VENTURES I LLC and)	
INTELLECTUAL VENTURES II LLC,)	Civil Action No. 2:14-cv-01130-MRH
)	
Plaintiffs,)	
)	
v.)	
)	
OLD REPUBLIC GENERAL)	
INSURANCE GROUP, INC.;)	
OLD REPUBLIC INSURANCE COMPANY;)	
OLD REPUBLIC TITLE)	
INSURANCE GROUP, INC.; and)	
OLD REPUBLIC NATIONAL TITLE)	
INSURANCE COMPANY,)	
)	
Defendants.)	

**Old Republic Defendants’ Notice of Supplemental Authority
Regarding PTAB Action On U.S. Patent No. 6,546,002**

Plaintiffs have asserted U.S. Patent No. 6,546,002, along with two other patents, against all defendants in this action. The Old Republic defendants moved under FRCP 12(b)(6) to dismiss IV’s infringement complaint regarding the ‘002 patent, as well as the other two patents asserted against it. Case No. 2:14-cv-01130, ECF 31 at 11-14 (opening brief); Case No. 1:14-cv-00220, ECF 56 (reply brief); and ECF 61 (supplemental brief on Federal Circuit case). During the April 14, 2015 hearing, the Court asked the undersigned what other actions involved the ‘002 patent; counsel identified, among other actions, Case IPR2015-00089 and Case IPR2015-00092, both of which involve petitions for *inter partes* review (“IPR”) before the Patent Trial and Appeal Board (“PTAB”) by International Business Machines Corporation (“IBM”) against Intellectual Ventures II LLC, a named plaintiff here. At the hearing, the Court also invited Notices of Supplemental Authority.

The Old Republic defendants respectfully submit this Notice of Supplement Authority

regarding two contemporaneous PTAB IPR decisions issued on April 27, 2015, attached hereto as Exhibits A and B, on IBM's two petitions. In sum, the PTAB has instituted IPR proceedings regarding the validity of almost all of the '002 patent's claims, finding that there is a reasonable likelihood that the claims are invalid because IBM's asserted art anticipated them or made them obvious. But the PTAB didn't address patent-eligibility under 35 U.S.C. §101, which is the subject of the Old Republic defendants' challenge here. Patent-eligibility issues under §101 can't be adjudicated in an IPR proceeding. Nonetheless, because the Court inquired about other proceedings involving the '002 patent, Old Republic submits this Notice. The following five points contain more specific detail.

1. IBM submitted two petitions for the PTAB's *inter partes* review of the '002 patent. The first was directed to claims 1-24, Exhibit A at 2; the other, to claims 25-49, Exhibit B at 2.

2. IBM filed the petitions pursuant to 35 U.S.C. §§311-319. Exhibit A at 2; Exhibit B at 2. Section 311 provides, with brackets and emphasis supplied, that "[a] petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent ***only on a ground that could be raised under section 102 [anticipation] or 103 [obviousness]*** and only on the basis of prior art consisting of patents or printed publications"; issues under §101 (patent-eligibility) are thus not subject to petitions for *inter partes* review.

3. Each petition asserted that the '002 patent's claims were invalid under either or both of 35 U.S.C. §102 or §103, based on the specific record that IBM submitted, which consisted of (a) expert testimony and (b) examples of the limited kinds of prior art allowable in IPR proceedings: patents and printed publications. Exhibit A at 2-4; Exhibit B at 2-4.

4. Based on IBM's evidence, the PTAB decided to institute anticipation and

obviousness review of all claims of the '002 patent except for six claims (claims 3, 5, 13, 15, 27, and 29) that require that the retrieved user-specific resources comprise "television channels" and "television program listings." Exhibit A at 2 (summarizing conclusions) & 21-23 (addressing television-specific claims 3, 5, 13, and 15); Exhibit B at 2 (summarizing conclusions) & 25-27 (addressing television-specific claims 27 and 29). The standard the PTAB applied in rendering its decision to institute IPR proceedings was whether IBM had shown a reasonable likelihood that the challenged claims were obvious over the asserted art. Exhibit A at 2; Exhibit B at 2 (each citing 35 U.S.C. §314(a)).

5. Thus, although the PTAB decisions instituting IPR proceedings implicate the '002 patent, those decisions aren't legally relevant to this Court's determination whether the '002 patent's claims aren't patent-eligible under §101.

Dated: April 28, 2015

Respectfully submitted,

s/ Vernon M. Winters

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